

Remarks

Applicants thank the Examiner for the indication that claims 13, 15-19, and 47 are allowed. Applicants also thank the Examiner for the indication that claim 12 contains allowable subject matter.

After entry of the foregoing amendments, claims 1, 3-10, 12, 13, 15-21, 25-27, 29, 32-38, 40, 42, 46-60, and 62-65 are currently pending. Claims 1, 25, 26, 27, 33, 42, 50, 56, and 62 have been amended. Claims 1, 25, 26, 27, 42, 56, and 62 have been amended for clarification purposes only and in the interest of advancing prosecution. Support for the amendments to claim 33 may be found in original claim 33. Claim 50 has been amended in the interests of advancing prosecution. No new matter is added by these amendments.

Section 112, First Paragraph Rejections

Claims 1, 3-5, 7-10, 38, 42, and 45 stand rejected under 35 U.S.C. § 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventors, at the time the application was filed, had possession of the claimed invention. Applicants have amended claim 1 to state that the proviso applies to formula Ia only. As shown at page 3, lines 24-28, Applicants respectfully submit that the claimed subject matter is properly described in the specification. Applicants therefore request that the rejection be withdrawn.

Claim 56 stands rejected under 35 U.S.C. § 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the art that the inventors, at the time the application was filed, had possession of the claimed invention. The Office action asserts that the second species is new matter as it is not described in the specification. In the interest of advancing prosecution, Applicants have amended claim 56 to delete the second species. Applicants respectfully submit that the rejection is now moot and request that it be withdrawn.

Section 112, Second Paragraph Rejections

Claim 26 stands rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which Applicants regard as the invention. In the interest of advancing prosecution, Applicants have amended claim 26 to delete “methoxy” and “ethoxy” from the list of possible substituents. Therefore, Applicants respectfully submit that the rejection is moot and request that it be withdrawn.

Claim 27 stands rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which Applicants regard as the invention. In the interest of advancing prosecution, Applicants have amended claim 27 to delete “p-MeO-Ph” from the list of possible substituents. Applicants respectfully submit that this rejection is now rendered moot and request that it be withdrawn.

Claim 25 stands rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which Applicants regard as the invention. The Office action asserts that there is insufficient antecedent basis for the limitation “one or more carbonyl groups, or one or more ether group or thioether groups” in the definition of R₆, R₇, and R₉ where R₆, R₇, and R₉ is an aryl group. In the interest of advancing prosecution, Applicants have amended claim 25 to delete the phrase. Applicants, therefore, respectfully submit that the rejection is now moot and request that it be withdrawn.

Claim 33 stands rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which Applicants regard as the invention. The Office action asserts that there is insufficient antecedent basis for the limitation “R₆ and R₉.” Applicants have amended claim 33 to properly reflect the subscripts. Therefore, Applicants respectfully submit that the rejection is now moot and request that it be withdrawn.

Claim 42 stands rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which Applicants regard as the invention. The Office action asserts that it is not known what is meant by the compounds of formula Ia or Ib where formula Ia and Ib are not shown as the pyrrolobenzodiazepine rings defined in the specification, but rather their open ring equivalents. Applicants have amended claim 42 to delete "Ia" and "Ib." Therefore, Applicants respectfully request that the rejection be withdrawn.

Claim 62 stands rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which Applicants regard as the invention. The Office action asserts that there is insufficient antecedent basis for the limitation "8-amino-1,2,3,11a-tetrahydropyrrolo[2,1-c][1,4]benzodiazepin-5-one." Applicants have amended claim 62 to be independent. Therefore, Applicants respectfully submit that the rejection is now moot and request that it be withdrawn.

Section 102 Rejections

Gregson et al.

Claims 50-55 stand rejected under 35 U.S.C. § 102(a) as being anticipated by Gregson et al. The Office action cites Gregson et al. as teaching or suggesting the compounds, compositions, and method of use of the compounds of formula II, where R₆ is hydrogen, R₇ is methoxy, R₈ forms the dimer through the bridge -O-(CH₂)-O-, R₉ is hydrogen, and R'₂ is CH₂. Moreover, the Office action asserts that the compounds where R₇ and R₈ together form the group -O-(CH₂)_p-O-, where p is 1 or 2 are not described in the priority documents. Applicants have amended claim 50 to remove this part of the definition of R₇ and R₈. Thus, Applicants respectfully submit that the claims, as amended, are entitled to the benefit of the Great Britain priority document. Therefore, Gregson et al. is not a proper reference and Applicants request that the rejection be withdrawn.

Provisional Obviousness-Type Double Patenting Rejections

U.S. Application Serial No. 09/763,813

Claims 1, 3-7, 20, 21, 25-27, 29, 32-38, 40, 42, 46, 48-56, 60, 63, and 65 stand rejected under the judicially created doctrine of obviousness-type double patenting over claims 17-19 of copending Application No. 09/763,813. Applicants respectfully submit that the allowed claims of the '813 application do not embrace the compounds claimed herein. In the '813 application, at least one of R₆, R₇ and R₈ must be X-Y-A-, where X is -COZ¹, NHZ, SH, or OH, where Z is either H or a nitrogen protecting group, Z¹ is either OH or an acid protecting group, Y is a divalent group such that HY=R, and A is O. That is not the case with the compounds claimed herein. Thus, Applicants respectfully submit that the provisional obviousness-type double patenting rejection is not proper and request that it be withdrawn.

U.S. Application Serial No. 10/379,049

Claims 42 and 57-59 stand provisionally rejected under the judicially created doctrine of obviousness-type double patenting over claim 31 of copending Application No. 10/379,049. Without conceding the propriety of the rejection, Applicants note that claim 31 of the '049 application has been cancelled and therefore, respectfully request that the rejection be withdrawn.

U.S. Application Serial No. 10/021,213

Claims 38, 50-55, and 64 stand provisionally rejected under the judicially created doctrine of obviousness-type double patenting over claims 1, 2, 4, 5, and 10 of copending Application No. 10/021,213. Applicants will file a terminal disclaimer at the time that the claims are deemed allowable.

Claim Objections

Claim 12 stands objected to as being dependent on a rejected base claim. Applicants thank the Examiner for the indication that claim 12 contains allowable subject matter.

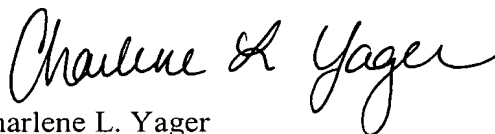
Allowable Subject Matter

Claims 13, 15-19, and 47 are allowed. Applicants thank the Examiner for the acknowledgement that none of the prior art teaches the compounds, compositions, or methods of use of compounds of formula II.

CONCLUSION

In view of the foregoing, Applicants respectfully submit that the claims as amended are in condition for allowance. The Examiner is invited to contact the undersigned by telephone should any issues remain with respect to the application.

Respectfully submitted,

A handwritten signature in black ink, appearing to read "Charlene L. Yager". The signature is fluid and cursive, with the first and last names being more prominent.

Charlene L. Yager
Reg. No. 48,887

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Michael Best & Friedrich LLP
One South Pinckney Street
P. O. Box 1806
Madison, WI 53701-1806
(608) 257-3501